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EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 10/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/560,222

Applicant(s)

HAEBERLI, PAUL

Examiner

Mark A Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The Examiner is in receipt of Applicant's response to Office Action mailed 8/27/2002, which was received by the Office October 9, 2002. The Office action acknowledged the restriction of claims 52-111. There were no amendments, cancellations or additions to the claims leaving claims 1-51 as pending in the application. The response from the Applicant has been carefully reviewed, but was found to be non-persuasive; therefore, the rejection is restated below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-17,20,21,22,23,33,34,36,37,38,41,42,44 rejected under 35 U.S.C. 102(e) as being anticipated by Morag (6,324,545).**

In regards to claim 1, Morag discloses a method comprising: automatically identifying an attribute of a first image; automatically selecting a new value, for a product attribute of an image-based product and incorporating at least a portion of the first image, based on the image attribute (col 4, lines 44-55); and receiving an order for the image-based product (**FIG 1**).

In response to claim 2, Morag teaches generating a first preview image of the image-based product (col 6, lines 45-65).

In response to claim 3, Morag teaches displaying the first preview image of the image-based product (col 6, lines 45-65).

In response to claim 4, Morag teaches wherein displaying the first preview image of the image based product includes: downloading the first preview image to a client computer; and displaying the first preview image on the client computer ((col 6, lines 45-65).

In response to claim 5, Morag teaches receiving the first image (col 6, lines 45-65).

In response to claim 6, Morag teaches wherein receiving the first image includes uploading the first image (col 6, lines 45-65).

In response to claim 7, Morag teaches wherein the first image is uploaded from a client computer to a server (col 6, lines 45-65).

In response to claim 8, Morag teaches wherein the first image is uploaded using a computer network (col 6, lines 45-65).

In response to claim 9, Morag teaches wherein the computer network includes the Internet (col 6, lines 45-65).

In response to claim 10, Morag teaches wherein receiving the first image includes storing the first image (col 6, lines 45-65).

In response to claim 11, Morag teaches wherein the first image is stored in an image database (col 6, lines 45-65).

In response to claim 12, Morag teaches wherein a plurality of images are received (col 6, lines 45-65).

In response to claim 13, Morag teaches receiving a selection of the first image from the plurality of images (col 6, lines 45-65).

In response to claim 14, Morag teaches displaying the plurality of images (col 6, lines 45-65).

In response to claim 15, Morag teaches wherein automatically identifying the image attribute includes analyzing the first image (claims 23-28).

In response to claim 16, Morag teaches wherein the new value for the product attribute is automatically selected based on the analysis of the first image (claims 23-28).

In response to claim 17, Morag teaches wherein analyzing the first image includes generating a set of representative colors from the first image (claims 23-28).

In response to claim 20, Morag teaches wherein automatically selecting the new value for the product attribute includes selecting a color as a function of at least one of the representative colors (col 1, line 64 to col 2, line 15).

In response to claim 21, Morag teaches wherein selecting the color as a function of at least one of the representative colors includes selecting a color that matches at least one of the representative colors (col 4, lines 44-55).

In response to claim 22, Morag teaches wherein selecting the color that matches at least one of the representative colors includes selecting a color that complements at least one of the representative colors (col 8, line 55 to col 9, line 22).

In response to claim 23, Morag teaches wherein selecting the color as a function of at least one of the representative colors includes selecting the color from the set of representative colors (see response to claim 18).

In response to claim 33, Morag teaches wherein the product attribute relates to which images are incorporated in the image-based product, and the image-based product further incorporates at least a portion of a second image (col 3, lines 8-25).

In response to claim 34, Morag teaches receiving a plurality of images; automatically identifying an image attribute of each of the received images; and automatically selecting the first and second images from the received images based on the image attributes of the received images (col 3, lines 8-25).

In response to claim 35, Morag teaches wherein automatically identifying an image attribute of each of the received images includes determining the orientation of each of the received images (col 3, lines 20-25).

In regards to claims 36 and 37, Morag teaches arranging the images based on content image weight and symmetry, therefore it is inherent in the teachings of Morag that there is process for distinguishing whether the picture is portrait or landscape and arranging the picture accordingly.

In response to claim 38, Morag teaches wherein the first and second images are selected from a subset of the received images having similar image attributes (col 3, lines 8-25).

In response to claim 41, Morag teaches fulfilling the order for the image-based product (**FIG 1**).

In response to claim 42, Morag teaches wherein the image-based product is an image print (**FIG 1**).

In response to claim 44, Morag teaches storing state information about the first image (col 3-1 to col 4, line 67).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 24,25,28-32,39,40, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morag.**

In regards to claims 24,25,28-32, Morag teaches selecting new values for attributes including color analyzing, but does not specifically mention all the selection methods claimed in the instant application. It is noted that the selection methods in claims 24,25,28-32 are old and well known in the art. It would be obvious to a person of



ordinary skill in the art to include in Morag these commonly used selection methods, because in order to speed up the processing and present an image back to the customer in a timely fashion, automated selection methods based on some kind of criteria would need to be introduced or the process would be slowed by requests for information from the customer.

In regards to claims 39 and 40, Morag teaches an image-based product is a diptych or a triptych. Morag teaches the assembly of a group of pictures into a photo album. Therefore, if the album included only 2 images it could be placed in a diptych or if the customer had 3 images it could just as well be placed in a triptych.

In response to claim 43, Morag teaches wherein the image-based product is a framed image print. Morag teaches supplying image prints to a customer, but does not specifically mention framing the picture. It is noted that the framing of pictures is old and well known in the art; therefore, if a large number of customers insisted on framed pictures, this feature could easily be added to the existing invention if Morag chose to incorporate frames.

**Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morag further in view of Lo (5,365,252).**

In response to claim 18, Morag teaches wherein generating the set of representative colors includes generating a color map for the first image. Morag teaches storing the color image, but does not specifically mention generating a color map or

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color look up table (CLUT). Lo teaches forming an index to a color table for all pixels of the color image and storing the index in memory (FIG 20, Item 214 and col 2, lines 5-13). It would be obvious to a person of ordinary skill in the art to include in Morag the color table as taught by Lo, because this table, commonly used in a computer's video adaptor, contains the color signal values that correspond to different colors that can be displayed on a color monitor (Microsoft Computer Dictionary 1999, Color look up table). Since Morag is displaying the colors indirectly, the color map would be a necessary feature to accomplish the storage of signal values related to the image.

In response to claim 19, Morag teaches wherein generating the color map includes performing a median cut algorithm on the first image. Morag teaches a process for adjusting and storing color of a provided image (claims 24), but does not specifically teach using a median cut algorithm. Lo teaches a median cut algorithm, which subdivides color space for a color image into smaller and smaller rectangular boxes (col 2, lines 13-22). It would be obvious to a person of ordinary skill in the art to include in Morag the median cut algorithm as taught by Lo, because Morag teaches changing the size of a color image and the use of a median cut algorithm is one method used to maintain the color with respect to the entire image.

**Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morag further in view of Jamzadeh et al. (5,140,348)**

In response to claim 26, Morag teaches wherein the product attribute is a

border color product attribute of the image-based product and the new value is the selected color. Morag teaches modifying color of an attribute, but does not specifically mention choosing the color for a border. Jamzadeh teaches an apparatus for creating border color in one of the dominant colors of a multicolor image (abstract). It would be obvious to a person of ordinary skill in the art to include in Morag, creating border color in one of the dominate colors of a multicolor image as taught by Jamzadeh, because having the ability to change the border electronically offers another option to the many adjustable characteristics that are available already in Morag (see also "back ground pattern" in col 2, line 47).

In response to claim 27, Morag teaches generating a second preview image of the image-based product having a border, wherein the color of the border is the color specified by the border color product attribute (see response to claim 26).

**Claims 45-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morag, and further in view of BusinessWire.**

In response to claims 45-51, Morag teaches modifying a digital image automatically or with user input over the Internet, but does not specifically mention the features of claims 45-51. BusinessWire teaches all the features in claims 45-51 (see entire article) or the features are old and well known in the art. It would be

obvious to a person of ordinary skill in the art to include in Morag the features of claims 45-51, because the features are common to the image print art and would be expected by the customer.

### ***Response to Arguments***

Applicant's arguments filed 10/9/2002 have been fully considered but they are not persuasive.

In regards to claims 1-17, 20-23, 33-38, and 41-44, Applicant argues the following:

In response to the argument that Morag is not analogous art (stated by Applicant particularly as "...the invention is completely different"), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the reference and the instant application are drawn to the manipulation of a photo image through a process provided over the internet.

In response to Applicants argument that Morag lacks at least two claimed elements the following is provided:

1) The applicant cites several paragraphs from the instant application which elaborate on the following claimed features: a) automatically identifying an attribute of a first image b) automatically selecting a new value, for a product attribute of an image

based product incorporating at least a portion of the first image, based on an image attribute.

In response to applicant's argument that the references fail to show certain features of applicant's invention as cited above, it is noted that the features upon which applicant relies (i.e., supporting information provided from the instant application, which elaborates on the claim, but is not distinctly claimed in the instant applicant.) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant further traverses the rejection by stating "Morag's receiving an order for the image-based product is done at the wrong sequence since Morag receives the order first before it generates an album (and not one image) for approval".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., generates an album and not one image and that there is a sequence in which the album is created then ordered.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, regarding the assertion that the Morag does not follow the same sequence, the Examiner points out that claim 1 does not claim a sequence where the

last action is that of placing an order as asserted by the Applicant, rather, the feature is claimed as another action that could occur at any time.

In regards to claims 24,25, 28-32, 39, 40, 43 and 45-51 applicant argues the following:

In response to applicant's argument that Jamzadeh, Lo and BusinessWire are nonanalogous art (stated by applicant as "Lo and Jamzadeh relate to hardware devices, which bear no resemblance to the invention, while BusinessWire is similar to Morag"), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Morag teaches a method of generating an album that automatically arranges at least some of the images to fit an album; Lo teaches a color image production apparatus with border color selection; and Lo teaches a method for forming a color map for use in displaying color images; and BusinessWire which teaches PC Photography software.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all of the cited references have the manipulation of a photographic/digital image in common.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Applicant's argument that the independent claims are allowable since Morag does not teach all the limitations in claim 1, the Examiner refers the applicant to the discussion of claim 1 above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

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***Washington D.C. 20231***

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"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Mark Fadok 

Patent Examiner

  
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